

Reply Under 37 C.F.R. § 1.116 – Expedited Procedure

Serial No.: 09/833,085

Examiner: Andrew J. Rudy

REMARKS

Claims 1 through 20 remain in this application. Claims 21 through 34 are currently withdrawn due to a restriction requirement.

The Office Action rejected Claims 1 through 20 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,618,630 to Jundt (the Jundt reference). However, the Office Action failed to provide for a prima facie case showing that the claims are obvious over the Jundt reference.

Official Notice

The first Office Action took “Official Notice” of “physical asset managers corresponding to an in repair substate of an un-installed state to an installed state, providing an installation operation, an de-installation operation, in-stock substate.” Applicants have not acquiesced to the “Official Notice” as asserted in the current Office Action on page 3. As specifically stated in the previous response, Applicants traversed the assertion of official notice and requested citation of prior art references disclosing the claim elements. Even though requested in the previous response, the current Office Action provides no such citation as required by M.P.E.P. 2144.03. As stated in M.P.E.P. 2144.03:

“It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known.”

The facts of the Official Notice are not well known and are not capable of instant and unquestionable demonstration as being well-known. As explained in the specification at page 1, lines 18 through 20, “In a conventional network management system, two separate physical equipment inventory management applications are used for providing network equipment inventory management capability.” This statement is directly contrary to the facts in the Official Notice. Thus, the Office Action was improper in taking Official Notice to facts that are not unquestionable as evidenced by the specification itself. Applicants have adequately provided reasoning why the noticed fact is not considered to be common knowledge as required under

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M.P.E.P. 2144.04, and respectfully request again citation of prior art references disclosing the claim elements.

Independent Claim 1 and dependent claims 2 through 19

Independent claim 1 states, “assigning system-readable identification to an asset item of a communication network; receiving, at a physical asset manager, said system-readable identification of the asset item in response to installing the asset item in the communication network; and creating an informational link between an on-line sub-object of the asset item and an off-line sub-object of the asset item, wherein said system-readable identification enables the physical asset manager to create the informational link between the on-line sub-object of the asset item and the off-line sub-object of the asset item.”

The Office Action merely states that the Jundt reference discloses “an informational link between an on-line subobject and off-line subobject” at columns 6-7. However, this quotation is not the full claim requirement. The claim requirement states, “creating an informational link between an on-line sub-object of the asset item and an off-line sub-object of the asset item, wherein said system-readable identification enables the physical asset manager to create the informational link between the on-line sub-object of the asset item and the off-line sub-object of the asset item.” Again, the Office Action nowhere specifies that the Jundt reference discloses or suggests this requirement of the claim. The cited part column 6-7 of the Jundt reference nowhere discussess creating an informational link between an on-line sub-object of the asset item and an off-line sub-object of the asset item. Instead, it discusses a “Field device management system” that performs “functions related to communicating with infivual devices to change the configuration or settings,” as stated at column 2, lines 24 through 29. Thus, the Jundt reference is only describing managing installed field devices and no where discloses an off-line subobject or creating an informational link between an on-line sub-object of the asset item and an off-line sub-object of the asset item, as required by the claims.

As explained above, Applicant again traverses the “Official Notice” of “physical asset managers corresponding to an in repair substate of an un-installed state to an installed state, providing an installation operation, an de-installation operation, in-stock substate.” As explained

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the specification at page 1, lines 18 through 20, “In a convention network management system, two separate physical equipment inventory management applications are used for providing network equipment inventory management capability.” Thus, the Office Action was improper in taking Official Notice to facts that are not unquestionable as evidenced by the specification itself. Applicants have adequately provided reasoning why the noticed fact is not considered to be common knowledge as required under M.P.E.P. 2144.04. Applicants respectfully request again citation of prior art references disclosing the claim elements.

Finally, the Office Action admits on page 3 that its cited motivation for modifying the Jundt reference (e.g. “would have been to keep track of common knowledge spare parts in an asset management system”) could be used for motivation to the known method of a second off-line inventory management system. Since there is no specific motivation to modify the Jundt reference to the claimed invention but only to the known methods, then only improper hindsight reasoning. “The court must be ever alert not to read obviousness into an invention on the basis of the applicant's own statements; that is, we must view the prior art without reading into that art appellant's teachings.” *Application of Nomiya*, 184 U.S.P.Q. 607, 612 (Cust. & Pat.App. 1975). The citation of the specification's own teachings to argue obviousness over prior art is improper. *In re Dembiczak*, 175 F.3d 994, 999, (criticizing hindsight syndrome wherein that which only the inventor taught is used against the teacher).

Independent Claim 20

Independent Claim 20 requires assigning a serial number and a part number to an asset item of a communication network, wherein the serial number and the part number are electronically stored on an electronic element of the asset; receiving, at a physical asset manager, the serial number and the part number of the asset item to a physical asset manager in response to installing the asset item in the communication network; performing an informational binding operation for associating information retrievable from an on-line persistent asset database with corresponding information retrievable from an off-line asset inventory database, wherein said system-readable identification enables the physical asset manager to create an informational link between the on-line sub-object of the asset item and the off-line sub-object of the asset item;

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enabling the display of a physical asset management view of an object corresponding to the asset item in response to creating the informational link, wherein the on-line sub-object of the asset item and the off-line sub-object of the asset item are capable of being integrally viewed in the physical asset management view; and preparing network planning information after creating the informational link.

The Office Action made no separate arguments on how the Jundt reference suggests the requirements of claim 20. As above, it merely states that the Jundt reference discloses “an informational link between an on-line subobject and off-line subobject” at columns 6-7. However, this quotation is not the full claim requirement. The claim requirement states, “performing an informational binding operation for associating information retrievable from an on-line persistent asset database with corresponding information retrievable from an off-line asset inventory database, wherein said system-readable identification enables the physical asset manager to create an informational link between the on-line sub-object of the asset item and the off-line sub-object of the asset item.” The Office Action nowhere specifies that the Jundt reference discloses or suggests this requirement of the claim.

The cited part column 6-7 of the Jundt reference nowhere discussess creating an informational link between an on-line sub-object of the asset item and an off-line sub-object of the asset item. Instead, it discusses a “Field device management system” that performs “functions related to communicating with invivial devices to change the configuration or settings,” as stated at column 2, lines 24 through 29. Thus, the Jundt reference is only describing managing installed field devices and no where discloses an off-line subobject or creating an informational link between an on-line sub-object of the asset item and an off-line sub-object of the asset item, as required by the claims.

As explained above, Applicant again traverses the “Official Notice” of “physical asset managers corresponding to an in repair substate of an un-installed state to an installed state, providing an installation operation, an de-installation operation, in-stock substate.” As explained the specification at page 1, lines 18 through 20, “In a convention network management system, two separate physical equipment inventory management applications are used for providing network equipment inventory management capability.” Thus, the Office Action was improper in taking Official Notice to facts that are not unquestionable as evidenced by the specification itself.

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Applicants have adequately provided reasoning why the noticed fact is not considered to be common knowledge as required under M.P.E.P. 2144.04. Applicants respectfully request again citation of prior art references disclosing the claim elements.

Finally, the Office Action admits on page 3 that its cited motivation for modifying the Jundt reference (e.g. “would have been to keep track of common knowledge spare parts in an asset management system”) could be used for motivation to the known method of a second off-line inventory management system. Since there is no specific motivation to modify the Jundt reference to the claimed invention but only to the known methods, then only improper hindsight reasoning. “The court must be ever alert not to read obviousness into an invention on the basis of the applicant’s own statements; that is, we must view the prior art without reading into that art appellant’s teachings.” *Application of Nomiya*, 184 U.S.P.Q. 607, 612 (Cust. & Pat.App. 1975). The citation of the specification’s own teachings to argue obviousness over prior art is improper. *In re Dembiczak*, 175 F.3d 994, 999, (criticizing hindsight syndrome wherein that which only the inventor taught is used against the teacher).

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CONCLUSION

For the above reasons, the foregoing amendment places the Application in condition for allowance. Therefore, it is respectfully requested that the rejection of the claims be withdrawn and full allowance granted. Should the Examiner have any further comments or suggestions, please contact Jessica Smith at (972) 477-9109.

Respectfully submitted,

ALCATEL

Dated: November 21, 2005
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